

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARGARET J. DESUTTER

Appeal No. 97-0520
Application 08/248,307¹

ON BRIEF

Before MCCANDLISH, *Senior Administrative Patent Judge*, and
MEISTER and ABRAMS, *Administrative Patent Judges*.

MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Margaret J. DeSutter (the appellant) appeals from the final
rejection of claims 1-9 and 15-22. Claim 10, the only other
claim remaining in the application, stands withdrawn from further

¹ Application for patent filed May 24, 1994. According to appellant,
this application is a continuation-in-part of Application 08/027,898, filed
March 8, 1993 (abandoned).

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consideration by the examiner under the provisions of 37 CFR
§ 1.142(b) as being directed to a nonelected species?

We REVERSE.

The appellant's invention pertains to (1) a direction-
indicating holder for a sign which is used to direct people to
a location associated with information on the sign and (2) to a
method of providing a directional indication to people that
utilizes such a holder and sign. Independent claims 1 and 22 are
further illustrative of the appealed subject matter and copies
thereof may be found in the appendix to the appellant's brief.

The references relied on by the examiner are:

Carmack	2,834,133	May 13, 1958
Nahon	3,696,532	Oct. 10, 1972
Bevan	3,826,026	July 30, 1974

The claims on appeal stand rejected under 35 U.S.C. § 103
in the following manner:

(1) claims 1-4, 6, 7, 9, 15-18 and 20-22 as being
unpatentable over Carmack in view of Bevan and

(2) claims 1, 5, 7, 8, 15 and 19 as being unpatentable over
Carmack in view of Nahon.

² Both the appellant and the examiner agree that the amendment filed on
February 23, 1996 (Paper No. 8), which added claims 24 and 25, has not been
entered. We observe, however, that the clerk inadvertently entered this
amendment.

The examiner's rejections are explained on pages 3-5 of the answer. The arguments of the appellant and examiner in support of their respective positions may be found on pages 5-13 of the brief³ and pages 5 and 6 of the answer.

OPINION

Having carefully considered the respective positions advanced by the appellant in the brief and the examiner in the answer, it is our conclusion that neither of the above-noted rejections is sustainable. In rejecting claims under 35 U.S.C. 103 the examiner bears the initial burden of presenting ***prima facie*** case of obviousness. ***In re Rijckaert***, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with evidence or argument shift to the applicant. ***Id.*** If the examiner fails to establish a ***prima facie*** case, the rejection is improper and will be overturned. ***In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

³ The appellant's brief is defective in that there is no grouping of the claims as expressly required by 37 CFR § 1.192(c)(7).

Here, the examiner proposes to modify the sign of Carmack in view of the teachings of either Bevan (rejection (1)) or Nahon (rejection (2)). The primary reference to Carmack does not teach a direction-indicating **holder** for an informational sign. Instead, Carmack teaches a highway sign **per se** that has two converging side edges which indicates a direction. In an attempt to overcome this deficiency the examiner has relied on the teachings of Bevan and Nahon and, while these two references teach holders for signs, neither teach a holder that has a **shape** which indicates a direction as expressly required by independent claims 1, 7, 15 and 22. That is, Bevan teaches a **rectangular** holder for a sign that is intended to be mounted on the door of an automobile and Nahon teaches a **rectangular** holder for memos.

In essence, what the examiner is proposing to do is to single out the concept of a holder for a sign from the teachings of Bevan and Nahon and incorporate it into the primary reference Carmack in such a manner that these **rectangular** holders are reshaped to included converging side edges that indicates a direction, even though all that Carmack teaches is a highway sign **per se** that has two converging side edges which indicates a direction. There is simply nothing in the combined teachings of Carmack and either Bevan or Nahon which would suggest such a

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modification. The examiner may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. **See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.**, 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), **cert. denied**, 484 U.S. 823 (1987) and **In re Kamm**, 452 F.2d 1052, 1057, 172 USPQ 298, 301-02 (CCPA 1972). While the examiner opines that such a modification would provide a means for the changing the information on the sign of Carmack, the mere fact that this is the case does not serve as a proper motivation or suggestion to combine the teachings of these references. Instead, it is the teachings of the prior art which must provide the motivation or suggestion to combine the references. **See In re Fritch**, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

From our perspective, the examiner has impermissibly relied upon the appellant's own teachings in arriving at a conclusion of obviousness. As the court in **Uniroyal, Inc. v. Rudkin-Wiley Corp.**, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988)

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stated, "it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

The examiner's rejections of the appealed claims under 35 U.S.C. § 103 are reversed.

REVERSED

HARRISON E. MCCANDLISH, Senior)	
Administrative Patent Judge)	
)	
)	
)	
JAMES M. MEISTER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
NEAL E. ABRAMS)	
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